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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/724,839

12/01/2003

Gregory Dean Sunvold

P147

2171

27752

7590

04/10/2007

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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EXAMINER

KHARE, DEVESH

ART UNIT

PAPER NUMBER

1623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

04/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/724,839

Applicant(s)

SUNVOLD ET AL.

Examiner

Devesh Khare

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-63 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction is required under 35 U.S.C. 121:

- I. Claims 18-31 and 56-63, drawn to a kit comprising a composition comprising fructooligosaccharide and information on how to use it, classified in classes 536/1.11; 435/810 and 424/725.
- II. Claims 1-17, drawn to the use of composition of Group I for a method of enhancing total tract digestibility of one or more dietary components in a companion animal, classified in classes 514/885; 536/1.11 and 424/76.1.
- III. Claims 32-55, drawn to the use of the use of composition of Group I for a method selected from the group consisting of enhancing calcium absorption, improving bone health, improving strength, improving physical activity performance and combinations thereof by administering the composition of group I to a companion animal, classified in classes 514/885; 536/1.11 and 424/76.1.

The inventions are distinct, each from the other because of the following reasons:

Groups I to II are related as product and process of making. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for making the product as claimed can be practiced with another materially different process or (2) the product as claimed can be made in a materially different process of making that product (MPEP § 806.05(h)). In the instant case the claims are drawn to the

Art Unit: 1623

use of composition of Group I which comprises fructooligosaccharide for a method of enhancing total tract digestibility of one or more dietary components in a companion animal, indicating that the instant method can be accomplished by materially different method. Zink et al. teach a lactic acid bacterial microorganism to improve or maintain gastrointestinal health in dogs and cats (U.S. 2003/0190309: [0009] and [0016]).

Groups I to III are related as product and process of making. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the use of composition of Group I for a method selected from the group consisting of enhancing calcium absorption, improving bone health, improving strength, improving physical activity performance and combinations thereof by administering the composition of group I to a companion animal can be practiced with another materially different method. Zink et al. teach a lactic acid bacterial microorganism to improve or maintain gastrointestinal health in dogs and cats (U.S. 2003/0190309: [0009] and [0016]).

Inventions II to III, are unrelated to one another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to two different inventions. Group II is drawn the use of composition of Group I for a method of enhancing

Art Unit: 1623

total tract digestibility of one or more dietary components in a companion animal, which is unrelated to the use of composition of Group I for a method selected from the group consisting of enhancing calcium absorption, improving bone health, improving strength, improving physical activity performance and combinations thereof by administering the composition of group I to a companion animal, of Group III. Two separate and distinct inventions have different functional effects. A different search would be required for each Group and neither would render the other obvious.

Although the inventions are classified in the same class and sub-class, searching the three groups of inventions constitutes a burdensome search, as a thorough search comprises a search of foreign patents and non-patent literature as well as the appropriate U.S. patent classifications. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper. It is noted that examination of the three independent and distinct inventions would indeed impose an undue burden upon the examiner in charge of this application.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143). If applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims, which depend from or otherwise include all the limitations of the allowable product claim will be considered for rejoinder. (MPEP § 821.04 and 821.04(b))

Art Unit: 1623

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

A telephone call was made to Cynthia Clay on 03/30/07, to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the

Art Unit: 1623

Examiner should be directed to Devesh Khare whose telephone number is (571)272-0653. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anna Jiang, Supervisory Patent Examiner, Art Unit 1623 can be reached at (571)272-0627. The official fax phone numbers for the organization where this application or proceeding is assigned is (703) 308-4556 or 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

d.khare
Devesh Khare, Ph.D., J.D.
Art Unit 1623
April 2, 2007